

**Notice of Allowability**

Application No.

09/750,130

Examiner

Jonathan Ouellette

Applicant(s)

FRANK ET AL.

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 12/5/2005.
2. ☒ The allowed claim(s) is/are 80,81 and 113-149.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☒ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☒ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☒ Notice of References Cited (PTO-892)
2. ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 20060124.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

## **DETAILED ACTION**

### **EXAMINER'S AMENDMENT**

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.
2. Authorization for this examiner's amendment was given in a telephone interview with the Attorney of record, Jeffrey Kuester (Reg.No. 34,367) on 1/24/2006.
3. The application has been amended as follows:
4. **Claim 124, line 17, before "comparing", add "automatically"; line 20, before "comparing", add "automatically"; line 23, before "selecting", add "automatically"; line 34, before "selected", add "automatically"; line 36, before "selected", add "automatically".**
5. **Claim 130, line 1, before "comparing", add "automatically"; line 4, before "determining", add "automatically".**
6. **Claim 131, line 5, before "comparing", add "automatically"; line 8, before "determining", add "automatically".**
7. **Claim 132, line 5, before "comparing", add "automatically"; line 8, before "determining", add "automatically".**
8. **Claim 133, line 3, before "comparing", add "automatically"; line 6, before "determining", add "automatically".**

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9. Claim 134, line 1, before “selecting”, add “automatically”; line 4, before “selecting”, add “automatically”.
10. Claim 135, line 1, before “selecting”, add “automatically”; line 4, before “selecting”, add “automatically”; line 8, before “selected”, add “automatically”.
11. Claim 136, line 1, before “selecting”, add “automatically”; line 4, before “selecting”, add “automatically”; line 8, before “selected”, add “automatically”; line 10 after “each” and before “selected”, add “automatically”; line 10, after “plurality of” and before “selected”, add “automatically”.

*Response to Amendment*

12. Claims 1-79 and 82-112 have been cancelled, Claims 114-149 have been added; therefore, Claims 80, 81, and 113-149 are pending in application 09/750,130.

*Claim Rejections 101, 102, and 103*

13. All outstanding claim rejections are withdrawn due to Applicant's Amendments.

*Allowable Subject Matter*

14. Claims 80, 81, and 113-149 are allowed.
15. The following is an examiner's statement of reasons for allowance:
16. As per **independent Claims 113, 124, and 137**, the prior art does not teach or suggest a method (computer-readable medium, computer system) for receiving subject matter submission information associated with subject matter; accessing intellectual property law

data stored in at least one intellectual property law database; accessing intellectual property business data stored in at least one intellectual property business database; automatically comparing the subject matter submission information against the intellectual property law data from the intellectual property law database; automatically comparing the subject matter submission information against the intellectual property business data from the intellectual property business database; automatically selecting, responsive to the comparison of the subject matter submission information against the intellectual property law data from the intellectual property law database, and responsive to the comparison of the subject matter submission information against the intellectual property business data from the intellectual property business database, at least one intellectual property rights protection system of the plurality of intellectual property rights protection systems for intellectual property rights protection for subject matter associated with the subject matter submission information; wherein the automatically selected at least one intellectual property rights protection system of the plurality of intellectual property rights protection systems includes at least one of a trademark protection system, a trade secret protection system, a copyright protection system, and a patent protection system.

17. **Hunter et al (US 6,298,327 B1)** discloses a method (system) for receiving subject matter submission information associated with subject matter (C8 L1-11, invention disclosures); accessing intellectual property law data stored in at least one intellectual property law database, automatically comparing the subject matter submission information against the intellectual property law data from the intellectual property law database, automatically determining if the submitted subject matter is patentable (C5 L38-46, patentability

determination knowledgebase system); and preparing applications for submission to intellectual property services (C4 L21-32).

18. However, Hunter fails to expressly disclose automatically comparing the submitted subject matter against the submission information against the intellectual property business data from the intellectual property business database; and automatically selecting responsive to the comparison of the subject matter submission information against the intellectual property law data from the intellectual property law database, and responsive to the comparison of the subject matter submission information against the intellectual property business data from the intellectual property business database, at least one intellectual property rights protection system of the plurality of intellectual property rights protection systems for intellectual property rights protection for subject matter associated with the subject matter submission information; wherein the automatically selected at least one intellectual property rights protection system of the plurality of intellectual property rights protection systems includes at least one of a trademark protection system, a trade secret protection system, a copyright protection system, and a patent protection system, as disclosed in the independent claims.
19. **Harshaw (US 6,542,871 B1)** discloses a method (system) for managing company product ideas, including: idea submission, idea evaluation, product development, obtaining proprietary protection, and marketing the idea (Fig.2, C1-C2).
20. However, Harshaw fails to disclose automatically comparing the idea submission to IP law database information and business information, in order to automatically select an appropriate form of intellectual property protection for said idea submission, as disclosed in the independent claims.

21. **Rivette et al. (US 5,991,751)** discloses a method (system) for obtaining and managing intellectual property information to include: patent information, trademark information, copyright information, and trade secret information (C99 L48-62, Claim 134). Rivette also discloses obtaining intellectual property protection on organizational innovations (C1 L13-35, C12 L17-18).
22. However, Rivette fails to disclose automatically comparing the organizational innovations to IP law database information and business information, in order to automatically select an appropriate form of intellectual property protection for said idea submission, as disclosed in the independent claims.
23. The remaining dependent Claims **80, 81, 114-123, 125-136, and 138-149** are considered allowable, as they are dependent and based off of an allowable independent claim.
24. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


### ***Conclusion***

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization


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where this application or proceeding is assigned (571) 273-8300 for all official communications.

27. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.



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January 24, 2006



**JOHN G. WEISS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**